PTO/SB/33 (07-09)
Approved for use through 07/31/2012. OMB 0651–0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

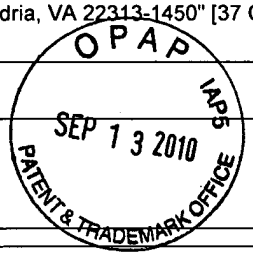
Docket Number (Optional)
7251/94662

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____



Application Number	Filed
10/589,417	7 November 2006

First Named Inventor
MAIL et al.

Art Unit	Examiner
2442	Michael W. Chao

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 37,135

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

_____
Signature

L. Friedman
Typed or printed name

(312) 655-1500
Telephone number

13 SEPTEMBER 2010
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

REASONS THAT PRE-APPEAL BRIEF REVIEW IS REQUESTED

Claims 1, 3-14, 17-21, 26-29, 31-42, 45-49 and 58-60 are pending. In the Final Office Action mailed 20 May 2010, claims 1, 3-14, 29 and 31-42 were rejected as being rendered obvious by Warsta (US 2004/0181550) in view of Malik (US 7,003,551), claims 17-21, 26-28 and 45-49 were rejected as being rendered obvious by Warsta in view of Malik and further in view of Kobata (US 2002/0077986), and claims 58-60 were rejected as being rendered obvious by Warsta in view of Malik and further in view of Mattis (US 6,128,623). The applicants submitted an after-final reply on 20 July 2010. An Advisory Action was mailed on 29 July 2010.

1. The Claims Recite Transcoding the Original Version of Content for Playback on a Second Device

Claim 1 recites, *inter alia*,

> storing an item of multimedia content as *stored multimedia content*...;
> ...transcoding said multimedia content for playback on a first multimedia device, thereby producing a firstly transcoded version...;
> * * *
> receiving... an instruction to forward said item of multimedia content to a second multimedia device, said instruction comprising a copy of said firstly transcoded version...;
> * * *
> ...in response to said instruction:
> * * *
> transcoding *said stored multimedia content* for playback on said second multimedia device.

[emphasis added]. That is, the content is stored and is transcoded for a first device producing a firstly transcoded version. An instruction that includes the firstly transcoded version is received to forward the content to a second device. In response to that instruction, the original version of the stored content is transcoded

for playback on the device. The other independent claims have substantially identical limitations as those quoted above from claim 1.

The quoted "said stored multimedia content" is the original version of the content introduced in the initial storing step of claim 1. It is *not* the the firstly transcoded version of that content that was attached to the instruction to forward the content to the second device. The significance of this was explained in the Background section of the application:

> when content that was previously transcoded for playback on one mobile subscriber device is sent from the mobile subscriber device to another mobile subscriber device, the transcoded content is typically transcoded again by the MMSC for playback on the intended recipient's device. This typically results in a lower playback quality than would be the case if the original content was transcoded for playback on the intended recipient's device.

1:31 – 2:5. In the method of claim 1, this problem is overcome because the transcoded content is *not* transcoded again for compatibility with the second device. Rather, the original version of the content is transcoded for compatibility with the second device. Therefore, there is no additional reduction in quality resulting from transcoding a previously transcoded version.

2. Warsta and the Other Cited References Do *Not* Disclose What is Claimed

Warsta and the other references on which the rejections relied do not disclose or suggest what is claimed. If device #1 sends content for delivery to device #2, the Warsta system checks if a version of that content that is compatible with device #2 is cached. If it is not cached, the Warsta system will transcode the content to be compatible with device #2. However, Warsta does *not* disclose or suggest that it will go back to the original version of the content, as opposed to transcoding the version sent from device #1 that already had been transcoded to be

compatible with device #1. This is the very problem quoted above from the background section of the captioned application. In this regard, Malik and the other references do not add anything to the Warsta disclosure.

In addressing the limitation reciting transcoding the original version of the content for playback on the second device, the bottom of page 6 and top of page 7 of the Final Office Action cited language in paragraphs 24 and 29 of Warsta. That cited language merely indicated that the Warsta system would check if it already had *stored* a version of the content that was adapted for playback on the "second device." That cited language and any other language in Warsta or in any of the other cited references does *not* disclose or suggest that, if transcoding is required for the "second device" (i.e., if a version adapted for playback on the "second device" is not available), the original version of the content would be transcoded (as claimed). There is *no* disclosure or suggestion that the Warsta system would not do exactly what other prior art systems do in this scenario. That is, there is *no* disclosure or suggestion that the Warsta system would not transcode the firstly transcoded version that was included in the instruction to forward the content to the second device, rather than transcoding the original version of the content as claimed.

The Advisory Action addressed a different claim limitation concerning *storing* the original version of the content. It did *not* address which version is transcoded in the scenario recited in the claims. It did *not* address the failure of the references to disclose or suggest the claim limitation discussed above.

Conclusion

For at least the foregoing reasons, the rejection of the claims is overcome, and allowance of the application is requested.

Respectfully submitted,

13 September 2010

L. Friedman
Reg. No. 37,135

HUSCH BLACKWELL LLP
WELSH KATZ
120 South Riverside Plaza, Suite 2200
Chicago, Illinois 60606
(312) 655-1500